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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,851	06/18/2001	Bogdan C. Maglich	HIENER.1CPC1CP	9955
20995	7590	12/23/2003	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			KEITH, JACK W	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3641	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,851

Applicant(s)

MAGLICH, BOGDAN C.

Examiner

Jack W. Keith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1016/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 10/16/2003 have been fully considered.

Applicant argues that the nonstatutory double patenting rejection of claims 1-17 as being not obvious. Applicant argues that the claim limitation "a target position being a first distance from the material or chemical substance" and the limitation "a particle detector being a second distance from the target position, the second distance larger than the first distance" are not present in co-pending application 09/788,736.

This argument is not persuasive. As previously set forth in paper no. 17 claims 1-17 although not identical are not patentably distinct from claims 1, 7 and 9-18 of co-pending Application No. 09/788,736 because each of the independent claim sets forth a particle generator, first and second subatomic particles, photon and alpha detectors and analyzers.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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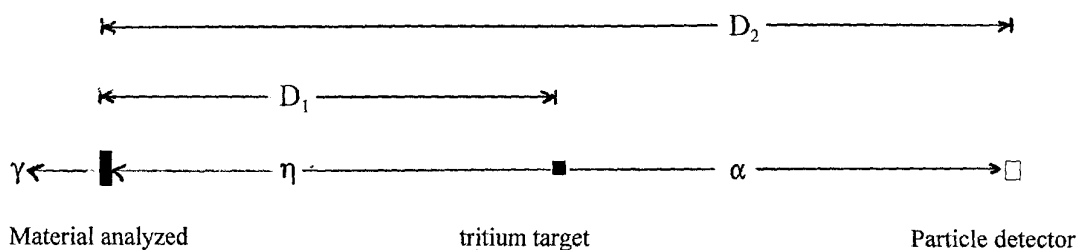
The 112, first paragraph rejection of Paper no. 17 is withdrawn. Applicant admitting that the subject filtering and analog-to-digital conversion being well known to one having ordinary skill in the art.

Applicant argues the 102(b) rejection of Sawa citing that the Sawa reference does not disclose the claim limitations "second subatomic particles at a target position which is a first distance from the material/chemical substance to be analyzed" and the limitation "a particle detector being a second distance from the target position, the second distance larger than the first distance".

The examiner disagrees. Sawa sets forth a prior art system capable of meeting applicant's claimed inventive concept. Note that prior art referred to in a reference patent may be used for what it fairly teaches. See In re Fortess and Schoeneberg, 152 USPQ 13. That is a particle generator (i.e., tritium target) generating first subatomic particles (neutrons) and second subatomic particles (alphas). The first subatomic particles (neutrons) and second subatomic particles (alphas) being emitted in opposite directions. These particles, both first and second subatomic particles, are generated at a first distance from the tritium target to the material to be analyzed (i.e., suitcase). A particle detector (i.e., a second subatomic particle (alpha) detector) is located near the tritium target. Therefore since it is well established that neutrons and alpha particles are emitted in opposite directions the distance from the particle detector of the Sawa prior art must be greater than the distance between the material to be analyzed and the tritium target. That is the particle detector must lie in the path of the second subatomic particles

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(alphas) in order to detect said second particles. That is the Sawa prior art system sets forth a second distance ( $D_2$ ) > first distance ( $D_1$ ). See below:



Referring now to the elected embodiment of figures 1-3 of Paper no. 9. Figure 1 clearly shows the claimed distances as being the same as those set forth in the prior art system of Sawa. Figure 1 shows a particle generator (18) generating first subatomic particles (neutrons)(14) and second subatomic particles (alphas) (16). The first subatomic particles (neutrons) and second subatomic particles (alphas) being emitted in opposite directions. These particles, both first and second subatomic particles, are generated at a first distance from the target to the material to be analyzed (i.e., suitcase). A particle detector (i.e., a second subatomic particle (alpha) detector)(28) is located near the tritium target. Thus, as in the Sawa prior art system applicant's particle detector is also near the target; however, this is not the claimed nor intended relationship in question. The relationship in question is the distance from the analyzed material to either the target or the particle detector. The prior art system of Sawa meets the claimed inventive concept.

To applicant's benefit claims are given their most reasonably broad interpretation, limitations are not read into the claims. Note that if applicant is arguing his inventive novelty to be the distance between the target and the particle detector (i.e., second distance) as being greater

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than the distance between the target and the substance analyzed (i.e., first distance) applicant's arguments are to a non-elected embodiment. Furthermore, such embodiment does not appear to be within the scope of the disclosure (i.e., new matter).

Accordingly, the prior art detection system as set forth in Sawa meets applicant's claim language. The 102(b) rejection of Paper no. 17 is herein incorporated by reference.

Applicant argues the 103 rejection of claims 1-4 and 13 of Sawa in combination with the admitted prior art citing that the combination of the admitted prior art would not have been obvious to one in the art. Applicant further argues that Sawa fails to disclose the first and second distances set forth in the claim language.

The examiner disagrees. First, the prior art system of Sawa as more fully set forth above discloses the subject claim limitations. Second, applicant's assertion that the use of the admitted prior art analyzer, processor, etc. is based upon improper hindsight reasoning by the examiner. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Clearly, modification of the prior art system of Sawa to have included the known analyzers (i.e., processors, filters, A/D converters, etc.) and detection systems (scintillators), as admitted by applicant as being conventional, would have been obvious to one having ordinary skill in the art at the time the

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invention was made as such results are in no more than the use of conventionally known techniques/designs within the contraband detection system art.

The 103 rejection of Paper no. 17 is herein incorporated by reference.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

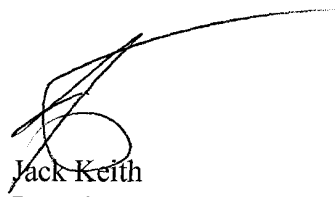
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Keith whose telephone number is (703) 306-5752. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198.

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The fax phone number for the organization where this application or the proceeding is assigned is (703) 305-7687. Fax number for submittals before Final is (703) 872-9326, After Final is (703) 872-9327 and customer service is (703) 872-9325.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Jack Keith  
Examiner,  
Art Unit 3641

jwk

December 17, 2003